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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,039	08/09/2000	Jamey Graham	15358-004240US	5597
20350 7590 07/08/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER CAMPBELL, JOSHUA D				
ART UNIT		PAPER NUMBER		
2178				
MAIL DATE		DELIVERY MODE		
07/08/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/636,039

**Applicant(s)**

GRAHAM ET AL.

**Examiner**

JOSHUA D. CAMPBELL

**Art Unit**

2178

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-19, 30-38 and 40-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-19, 30-38 and 40-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 10/25/2007, 11/2/2007, 1/9/2008



### **DETAILED ACTION**

1. This action is responsive to communications: Request for reconsideration filed 3/6/2008 and IDS's filed on 10/27/2007, 11/2/2007, and 1/9/2008.
2. Claims 11-19, 30-38, and 40-44 are pending in this case. Claims 11, 19, 30, 38, 40, and 41 are independent claims.

### ***Information Disclosure Statement***

3. The information disclosure statements filed fail to fully comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the communications received from the JPO that have been crossed out in the IDS's are completely in Japanese. They have been placed in the application file, but the information that is crossed out has not been considered as to the merits. The items must at least contain a concise explanation of their relevance in order to be considered. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Claim Objections***

4. Claims 34 and 35 are objected to because of the following informalities: the claims appear to depend from claim 33, however the preamble of the claims states that

they depend from claim 43 which appears to be only a typographical error. For the purposes of examination, the claims will be examined as though they depend from claim 33. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 11-14, 17 18, 30-33, 36, 37, and 40 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999) in view of Hart et al. (hereinafter Hart, US Patent Number 5,546,502, issued August 13, 1999) further in view of Nathan et al. (hereinafter Nathan, US Patent Number 6,326,957, filed January 29, 1999).

**In regard to independent claim 11**, Acrobat discloses a method in which a document is accessed and a section of that document is shown in a first area and thumbnails of the document are displayed in a second area (Page 1-3 of Acrobat). Acrobat also discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to correctly place the information in the thumbnail representation (Page 1-3 of Acrobat). Acrobat also discloses that the portion of the thumbnail window corresponding to the part of the document being displayed is highlighted (emphasized) and changed dynamically as the portion that is viewed is changed to a different portion (Page 1-4, items 1-4 of Acrobat, the box in the thumbnail changes based on the portion being

viewed). Acrobat discloses a method in which determining information about a document (coordinates and dimension) includes determining information about text, forms, graphics, images, and links (Pages 1-5 of Acrobat).

Acrobat does not disclose a method in which the user selects from plurality of concepts rather than entering a query, the concepts having keywords associated with them. However, Hart discloses a method in which a user selects concepts (symptoms) and the system searches for the concepts and commonly known keywords (faults) associated with the concepts in the document and presents the sections of the document that deal with the concepts and text patterns associated with the concepts (symptoms and faults) out to the user (column 3, line 39-column 4, line 61 of Hart). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Acrobat with the query-free teachings of Hart because it would have provided relevant documentation for the current context more efficiently without the user having to formulate a query and wait for results (column 6, lines 31-44 of Hart).

Acrobat also does not disclose dynamically changing the contents of the single thumbnail image to reflect a change in the contents of the document. However, Nathan teaches dynamically maintaining thumbnail images to keep them concurrent with the document they represent by dynamically updating the content of the image (column 6, lines 14-18 of Nathan et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Acrobat with

the teachings of Nathan because it would have allowed the thumbnail image to correctly represent the most current state of the document regardless of any changes made.

**In regard to dependent claim 12**, Acrobat discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to correctly place the information in the thumbnail representation (Page 1-3 of Acrobat).

**In regard to dependent claim 13**, Acrobat discloses a method in which the thumbnail sizes can be changed to a different reduction level (reduction ratio) and the content still correctly corresponds to the original document (Page 1 and 5, Items 1 and 5 of Acrobat).

**In regard to dependent claim 14**, Acrobat does not disclose a method in which the selects from plurality of concepts rather than entering a query, the concepts having keywords associated with them. However, Hart discloses a method in which a user selects concepts (symptoms) and the system searches for the concepts and commonly known keywords (faults) associated with the concepts in the document and presents the sections of the document that deal with the concepts and text patterns associated with the concepts (symptoms and faults) out to the user (column 3, line 39-column 4, line 61 of Hart). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Acrobat with the query-free teachings of Hart because it would have provided relevant documentation for the current context more efficiently without the user having to formulate a query and wait for results (column 6, lines 31-44 of Hart).

**In regard to dependent claim 17**, Acrobat discloses a method in which determining information about a document (coordinates and dimension) for creating thumbnail representations of the document incorporate all formatting of that document (Pages 1-5 of Acrobat).

**In regard to dependent claim 18**, Acrobat discloses a method in which determining information about a document (coordinates and dimension) includes determining information about text, forms, graphics, images, and links (Pages 1-5 of Acrobat).

**In regard to independent claim 30 and dependent claims 31-33 and 36-37**, the claims incorporate substantially similar subject matter as claims 11-14 and 17-18. Thus, the claims are rejected along the same rationale as claims 11-14 and 17-18.

**In regard to independent claim 40**, the claim incorporates substantially similar subject matter as claim 11. Thus, the claim is rejected along the same rationale as claim 11.

7. Claims 15, 19, 34, 38, and 41-43 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999) in view of Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) further in view of Hart et al. (hereinafter Hart, US Patent Number 5,546,502, issued August 13, 1999) and further in view of Nathan et al. (hereinafter Nathan, US Patent Number 6,326,957, filed January 29, 1999, cited by the examiner in PTO-892 mailed on 12/15/2006).



**In regard to dependent claim 42**, Acrobat does not disclose that text entities are annotated according to style information if they are relevant to any of a plurality (first and second) of concepts. However, Nielsen discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts), which are received from the user (column 1, line 17-column 2, line 16 of Nielsen). Nielsen discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (column 1, line 17-column 2, line 16 of Nielsen). The text patterns that match the queries are then marked using tags and highlighted with color (annotated) to emphasize their position as the document is viewed (column 1, line 17-column 2, line 16 of Nielsen). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Nielsen because it would have provided a user with a simple way to search and identify terms when viewing a document.

**In regard to dependent claim 15**, Acrobat discloses a method in which the thumbnail representations of the document incorporate all formatting of that document which would include highlighted text entities (Pages 1-5 of Acrobat).

**In regard to independent claim 19**, Acrobat discloses a method in which a document is accessed and a section of that document is shown in a first area and thumbnails of the document are displayed in a second area (Page 1-3 of Acrobat). Acrobat also discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to

correctly place the information in the thumbnail representation (Page 1-3 of Acrobat). Acrobat also discloses that the portion of the thumbnail window corresponding to the part of the document being displayed is highlighted (emphasized) and changed dynamically as the portion that is viewed is changed to a different portion (Page 1-4, items 1-4 of Acrobat, the box in the thumbnail changes based on the portion being viewed).

Acrobat does not disclose that text entities are annotated according to style information if they are relevant to any of a plurality of concepts. However, Nielsen discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts), which are received from the user (column 1, line 17-column 2, line 16 of Nielsen). Nielsen discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (column 1, line 17-column 2, line 16 of Nielsen). The text patterns that match the queries are then marked using tags and highlighted with color (annotated) to emphasize their position as the document is viewed, in a manner that is independent of a second query being made (column 1, line 17-column 2, line 16 of Nielsen). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Nielsen because it would have provided a user with a simple way to search and identify terms when viewing a document.

Neither Acrobat nor Nielsen disclose a method in which the selects from plurality of concepts rather than entering a query, the concepts having keywords associated with them. However, Hart discloses a method in which a user selects concepts (symptoms) and the system searches for the concepts and commonly known keywords (faults) associated with the concepts in the document and presents the sections of the document that deal with the concepts and text patterns associated with the concepts (symptoms and faults) out to the user (column 3, line 39-column 4, line 61 of Hart). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Acrobat and Nielsen with the query-free teachings of Hart because it would have provided relevant documentation for the current context more efficiently without the user having to formulate a query and wait for results (column 6, lines 31-44 of Hart).

Acrobat also does not disclose dynamically changing the contents of the single thumbnail image to reflect a change in the contents of the document. However, Nathan teaches dynamically maintaining thumbnail images to keep them concurrent with the document they represent by dynamically updating the content of the image (column 6, lines 14-18 of Nathan et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Acrobat with the teachings of Nathan because it would have allowed the thumbnail image to correctly represent the most current state of the document regardless of any changes made.

**In regard to dependent claims 34 and 43**, the claims incorporate substantially similar subject matter as claims 15 and 42. Thus, the claims are rejected along the same rationale as claims 15 and 42.

**In regard to independent claims 38 and 41**, the claims incorporate substantially similar subject matter as claim 19. Thus, the claims are rejected along the same rationale as claim 19.

8. Claims 16 and 35 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999) in view of Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) further in view of Hart et al. (hereinafter Hart, US Patent Number 5,546,502, issued August 13, 1999), further in view of Nathan et al. (hereinafter Nathan, US Patent Number 6,326,957, filed January 29, 1999, cited by the examiner in PTO-892 mailed on 12/15/2006), and further in view of Okamoto et al. (hereinafter Okamoto, US Patent Application Publication Number 2002/0065814, US Filing date June 30, 1999).

**In regard to dependent claim 16**, none of Acrobat, Nielsen, Hart, or Nathan disclose a method in which the style information relevant to a concept is modified and in response all entities that correspond to that concept are changed to correspond with the new style information. However, Okamoto discloses a method in which a concept tag number, which corresponds to one of a plurality of concepts, is directly associated with a specific style (page 12, paragraph 0270-0276 of Okamoto). When that style information is changed all tags corresponding to the tag number associated with that

style information will reflect that change (page 12, paragraph 0270-0276 of Okamoto). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Okamoto because it would have provided a user with a simple way to search and customize the identification of terms when viewing a document.

**In regard to dependent claim 35**, the claim incorporates substantially similar subject matter as claim 16. Thus, the claim is rejected along the same rationale as claim 16.

### ***Response to Arguments***

9. Applicant's arguments filed 3/6/2008 have been fully considered but they are not persuasive.

Regarding applicant's arguments on pages 11-13 with respect to the claims finding support in the parent application, the examiner maintains that the rejection is proper due to the fact that the not every single limitation of the independent claims are supported by the parent application. The applicant has failed to show that each and every limitation of the independent claims exists in the parent application, and after examining the parent application the examiner believes that this is due to the fact that the parent application does not disclose each and every limitation of the independent claims. The examiner can find no basis for the limitation of claim 11, starting on line 13 that states, "...dynamically changing the contents of the single thumbnail image to

reflect a change in the contents of the document displayed in the first viewing area."

The applicant has provided multiple citations of the specification that are believed to provide support for this limitation, however these citations do not provide the support necessary to properly enable the invention. The idea of dynamically updating a document with annotations is discussed at only point in the specification, page 6, line 26-page 7, line 6 of application 08/995,616, which states, "The annotations are not preferably pre-inserted into the text but are rather generated when user 504 requests document 502 for browsing. Thus, this is preferably a dynamic process." This cited section refers to the fact that the annotations are added to the document at the time of request and prior to the display of the document, which in effect does not provide the necessary support for the claimed limitations. The only discussion of the idea that the thumbnail contains the annotations states, "Elongated thumbnail image 214 provides a convenient view of the basic document structure. The annotations incorporated into the document are visible within elongated thumbnail image 214," (page 12, lines 9-11 application 08/995,616), which again does not provide any basis for the idea that the thumbnails content is dynamically updated, rather merely providing that the annotations added to the document at the time of request, prior to display of the document are also added to the thumbnail image prior to it's display. This does not correspond to the dynamic thumbnail (a thumbnail which is actually updated dynamically) as defined in the specification of the current application (page 28, line 24-page 29, line 10 of applicant's specification). The applicant argues in response, "If the annotations are dynamically updated in the document described above, the corresponding annotations displayed in

the thumbnail image are also updated," however the applicant has not provided any indication of where this could be found in the parent application, and after careful review the examiner believes it does not exist in the parent application. Thus, the examiner's position on the claims with respect to priority will be maintained, a claim will not be granted the date of a parent application unless each and every limitation of the claim is fully supported by the parent application, due to the fact that this is not the case the parent date will not be granted in the case of these independent claims. Thus, the art references are not antedated and the rejection remains proper.

Regarding applicant's arguments on pages 13-17 with respect to the rejection of the claimed limitation, "...dynamically changing the content of the single thumbnail image to reflect the change in the contents of the document in the first viewing area," the examiner maintains that the rejection is proper. Nathan teaches dynamically maintaining thumbnail images to keep them concurrent with the document (digital page) that they represent by dynamically updating the content of the image (column 6, lines 14-18 of Nathan). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Acrobat with the teachings of Nathan because it would have allowed the thumbnail image to correctly represent the most current state of the document regardless of any changes made. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The

combination of the teachings of Acrobat with the teachings of Nathan properly rejects the limitation as described above. Nathan teaches that a thumbnail image representing a document should be dynamically updated and Acrobat teaches that a document viewing area would contain a document in one viewing area and a thumbnail representation of the document in a second viewing area. Thus, one of ordinary skill in the art would have seen it obvious to have dynamically updated the thumbnail in the second viewing area of Acrobat based on the teachings in Nathan. Thus, the rejection is proper and will be maintained.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA D. CAMPBELL whose telephone number is (571)272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua D Campbell/  
Primary Examiner, Art Unit 2178  
June 30, 2008